



AF/2861

**Patent Application
Attorney Docket No. D/99720C**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brian E. Springett, et al.

Application No.: 10/010,202

Filed: December 10, 2001

Examiner: H. TRAN

Art Unit: 2861

Title: TRANSFER SHEET PRINTING PROCESS
FOR DECORATING ARTICLES FORMED BY
USING A DIGITALLY CONTROLLED PRINTING
MACHINE

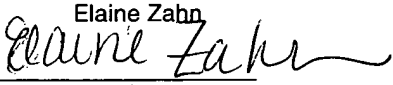
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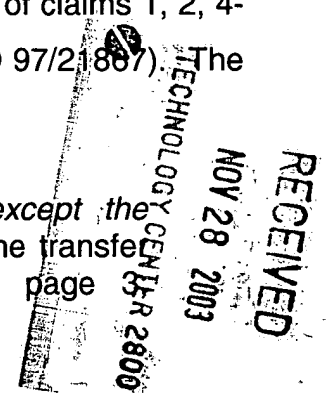
Elaine Zahn

(Signature)

November 11, 2003

REPLY BRIEF

This Reply Brief (37 CFR §1.193(b)(1)) responds to the Examiner's Answer (dated September 17, 2003) sustaining his rejection of claims 1, 2, 4-6 and 8-10 under 35 USC §102(b) based upon Franke (WO 97/21867). The Examiner states:

"...the elements of the claimed transfer sheet *except the process step used to deposit the various layers* of the transfer sheet are met by Franke." (Examiner's Answer, page emphasis added.)



The Examiner takes the position that the process used to deposit the various layers of the transfer sheet is not given patentable weight — pursuant to guidelines set forth in MPEP 2113 with respect to product-by-process claims. (Examiner's Answer, page 3.)

MPEP 2113

One decision providing support for MPEP 2113 includes the case of *In re Thorpe*, 777 F.2d 695; 227 USPQ 964 (Fed. Cir. 1985), which stands for the proposition that: “[i]f the product in the...claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”

It is respectfully submitted that the case of *In re Thorpe* is inapplicable, however, because the Appellants have consistently argued that the process limitation of their claims 1, 2, 4-6 and 8-10 render their claimed inventions neither the same as, nor anticipated by, the prior art as disclosed by Franke. (See, e.g., Remarks dated February 19, 2003 at pages 3-4.) Furthermore, the process limitation of claims 1, 2, 4-6 and 8-10 (for reasons set forth in these Remarks) render the claimed inventions *not* obvious in view of Franke.

Another decision providing support for MPEP 2113 is the case of *In re Garnero*, 412 F.2d 276; 162 USPQ2d 221 (CCPA 1979), which stands for the proposition that the process limitation should impart distinctive structural characteristics to the final product.

In this regard, the Appellants *have* argued that the claimed process limitation (of their claims 1, 2, 4-6 and 8-10) *does* impart distinctive structural characteristics to the final products claimed. (See also, e.g., Remarks dated February 19, 2003 at pages 3-4.)

Still another court decision providing support for MPEP 2113 is the case of *In re Marosi*, 710 F.2d 798; 218 USPQ 289 (Fed. Cir. 1983), which

stands for the proposition that the burden shifts to the Appellants to come forward with evidence establishing an unobvious difference between the claimed products and the prior art product(s).

In this regard, too, Appellants have pointed to supporting evidence in their specification, sufficient to establish an unobvious difference between claimed products and the prior art products. (See, e.g., Remarks dated February 19, 2003 at pages 3-4.)

The Pending Claims

Claims 1, 2, 4, 9 and 10 (each independent) are (each) directed to:

“a transfer sheet, including: a carrier sheet; a colored pattern printed on a surface of said carrier sheet using at least one digitally controlled color printer;... .” (See, e.g., Appellants’ Brief at pages 6-8.)

Additional limitations rendering claims 1, 2, 4-6 and 8-10 patentably distinct, and support (for such claims) in the Specification, is also noted. (See, e.g., Appellants’ Brief at pages 6-8.)

In re Dembiczak

In re Dembiczak, 175 F.3d 994; 1999 U.S.App.Lexis 8109; 50 USPQ2d 1614 (Fed. Cir. 1999) involved a pumpkin bag. All of the independent claims on appeal—namely 37, 52, 72 and 74—contained limitations that the bag must be “premanufactured orange in color” and have “facial indicia”. (See, e.g., *Dembiczak* at Lexis page 5 of 12.)

In *Dembiczak*, after carefully considering the PTO Board of Appeals’ obviousness determinations and noting the Board’s position that:

“the *only difference* between the invention presently defined in the independent claims on appeal and the orange plastic trash bags of

the prior art (and the use of such bags) resides in the *application of the facial indicia to the outer surface of the bag*" (*Dembiczak* at Lexis page 6 of 12; emphasis added),

the Federal Circuit went on to reverse the PTO (and Examiner), pointing out that the Board's conclusion in support of its rejection of the claims was *not* supported by the record. (*Dembiczak* at Lexis page 9 of 12; emphasis added.)

In re Sernaker

In re Sernaker, 702 F.2d 989; 1983 U.S.App.Lexis 13565; 217 USPQ 1 (Fed. Cir. 1983) involved an embroidered transfer emblem. (See, e.g., claim 10, in *Sernaker* at Lexis page 3 of 13.) The transfer emblem comprised:

"an embroidered pattern on one side of a substrate whose size corresponds to the size of the pattern with thread of a single color... , portions of the pattern having a sculptured effect by an increased number of thread stitches, at least two colors of dyestuff printed on the thread stitches... , *said colors being in registry* with said sculptured portions of said pattern...". (See, e.g., *Sernaker* at Lexis page 3 of 13; emphasis added.)

In *Sernaker*, the Federal Circuit initially noted that when "the inventor uses ... '*in registry*,' he appears by the context to mean...placed in correspondence." (*Sernaker* at Lexis page 4 of 13; emphasis added.) Next, after carefully considering the PTO Board of Appeal's obviousness determinations, the Federal Circuit pointed out that:

"embroidery is introduced *between* the print and the substrate. No print is *applied to* the substrate. ... The pattern, being 'sculpted,' intercepts the colors in the print according to

the designer's intentions. The print and the pattern (embroidery) are [thus] *made to 'register' ... i.e., conform.*" (Sernaker at Lexis page 9 of 13; emphasis added.)

Based on such findings, the Federal Circuit went on to reverse the PTO (and Examiner), holding that the Board had "pointed to no prior art that...suggested...[such a] combination." (Sernaker at Lexis page 9 of 13.) Without referring to the individual pending claims in detail, it is again briefly pointed out, where it is *not possible* to define characteristics which make individual claims inventive *except by referring to the process* by which each claimed article is made, that the Appellants (in reference to each such claim) *have* argued such. Moreover, as noted previously, the Appellants *are* permitted to so claim their articles. (See, e.g., Appellants' previous Remarks dated February 19, 2003 at pages 3-4, in reliance upon the case of *Atlantic Thermoplastics v. Faytex*, 970 F.2d 834; 1992 U.S.App.Lexis 15888; 23 USPQ2d 1481 (Fed. Cir. 1992); emphasis added.)

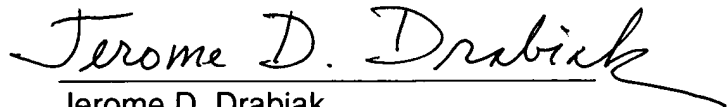
Conclusion

Accordingly, it is respectfully submitted that presently pending claims 1, 2, 4-6 and 8-10 are patentably distinct from the Franke reference, and that such a position is supported by court decisions cited by the Appellants in previous Remarks as well as the rationale of newly-cited Federal Circuit opinions (finding that claimed articles having process limitations are patentable) briefly mentioned above in this Reply Brief.

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For these reasons it is respectfully urged that the Examiner's rejection(s) of claims 1, 2, 4-6 and 8-10 be withdrawn, and that the application be passed to issue.

Respectfully submitted,



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